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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
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| 10/628,329 | 07/29/2003 | Ken Kennedy | P45603 | 6103 |

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RICHES, MCKENZIE & HERBERT, LLP
SUITE 1800
2 BLOOR STREET EAST
TORONTO, ON M4W 3J5
CANADA

EXAMINER

WONG, STEVEN B

| ART UNIT | PAPER NUMBER |
|----------|--------------|
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3711

DATE MAILED: 03/28/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

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|------------------------------|--------------------------------------|-------------------------------------|--|
| Office Action Summary | Application No. 10/628,329 | Applicant(s) KENNEDY, KEN | |
| | Examiner Steven Wong | Art Unit 3711 | |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 03 August 2004.
 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-5 is/are pending in the application.
 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
 5) ☐ Claim(s) _____ is/are allowed.
 6) ☒ Claim(s) 1-5 is/are rejected.
 7) ☐ Claim(s) _____ is/are objected to.
 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 a) ☐ All b) ☐ Some * c) ☐ None of:
 1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
 * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

Claim Rejections - 35 USC § 112

1. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

2. Claims 3, 4/3 and 5/3 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. The amendment further defines the movable member set forth in Figure 5 and claim 3, however the structure of the movable member is still not clear. For example, it is unclear how the movable member is retained in the opening and if the movable member is retained in the opening after movement or if it is attached to the ball marker. The specification merely states that the movable member, when pushed by the user's finger, moves a distance away from the magnetic material to release the ball marker from the depression.

Claim Rejections - 35 USC § 103

3. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.
4. Claims 1-5 are rejected under 35 U.S.C. 103(a) as being unpatentable over Tate (5,295,683). Regarding claim 1, Tate discloses a golf divot repair tool comprising a body (12), a pair of pointed arms (14, 16), a depression (18), a magnetic material (32) disposed in the depression, a ball marker (26) constructed of a material attracted to the magnet and an opening (34) formed through the depression. It would have been obvious to one of ordinary skill in the

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art to form the opening of a larger size in order to accommodate ball markers with bigger posts or in order to allow the user to more easily insert the post in the opening in the body. By enlarging the opening in Tate, a user would obviously be able to insert their finger through the opening. It is noted that the limitation "to allow a finger to be inserted through said opening" is considered to be broad as a user's finger could be in a wide range of sizes.

Regarding claim 2, it would have been obvious to one of ordinary skill in the art to form the opening of Tate in the range of 5mm to 40mm in order to accommodate ball markers with larger posts or in order to allow the user to more easily insert the post in the opening in the body.

Regarding claim 3, insofar as this claim may be understood, Tate teaches the claimed structure by providing a movable member (30) disposed in the opening (note Figure 2) which, when moved, moves the ball marker away from the magnetic material.

Regarding claim 4, it would have been obvious to one of ordinary skill in the art to form the magnet of Tate as two separate pieces in order to eliminate the need to replace the entire magnet should part of it become damaged.

Regarding claim 5, note Figure 4 of Tate showing an annular magnet (32) centered in the depression.

5. Claims 1-5 are rejected under 35 U.S.C. 103(a) as being unpatentable over Tate (5,295,683) in view of Dimmick et al. (4,822,052). Dimmick merely teaches that it is well known in the art of golf ball markers to provide posts of different sizes and shapes. It would have been obvious to one of ordinary skill in the art to enlarge the opening of Tate in order to accommodate ball markers with bigger posts. Enlarging the opening the ball marker of Tate would obviously permit the user to insert his finger therethrough.

Response to Arguments

6. Applicant's arguments filed August 3, 2004 have been fully considered but are not deemed to be persuasive. Regarding the rejection under 35 U.S.C. 112, the applicant's amendment has failed to overcome the rejection set forth in the previous Office Action. The applicant draws attention to page 4 of the specification and adds new Figure 5, however, the construction of the movable member is still unclear for the reasons set forth above in the rejection under 35 U.S.C. 112.

Regarding the rejection under 35 U.S.C. 102, this rejection has been withdrawn and replaced with a rejection under 35 U.S.C. 103 where it is found to be obvious to one of ordinary skill in the art to enlarge the opening of Tate in order to accommodate ball markers with bigger posts. The applicant argues that the instant structure is different than the structure of Tate in that the instant structure does not require the post as provided by Tate. However, this is not persuasive as the instant claims fail to preclude the use of a post as provided by Tate. Further, it should be noted that the instant claims use the open language "comprising" which would permit the addition of a post to the instant claims. Moreover, the language defining the size of the opening "of sufficient size to allow a finger to be inserted through said opening" is seen as broad language as user's fingers come in various sizes. For example, if the user was a very small child his finger would obviously need an opening of a much smaller size than that required by a fully grown adult. Further, the applicant's claim 2 is an evidentiary showing of the broad range that would be encompassed by the size limitation of claim 1. Claim 2 recites a range between 5 mm and 40 mm. The 5 mm limit would be of a similar size to that disclosed by Tate or Tate in view of Dimmick.

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Regarding the applicant's argument that the instant invention is used in an entirely different approach than the invention of Tate, this is not seen. Both inventions are directed to the removal of a magnetically retained golf ball marker from a divot repair tool. Both inventions are removed by applying force by the user's finger to the backside of the ball marker. The only claimed difference between the instant invention and the Tate reference is the recitation for the size of the opening to be sufficient to permit a user's finger therethrough. However, this limitation is obviated by the enlargement of the opening of Tate to accommodate posts of varying sizes (as evidenced by Dimmick).

Regarding the applicant's contention that the instant ball marker is usable on both sides whereas the marker of Tate is one-sided, this argument is not persuasive as the claim language fails to limit the ball marker to being two-sided as argued. The claims only define the ball marker as being of a material attracted by magnetism and fail to preclude the addition of a post to one side thereof.

Conclusion

7. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event,

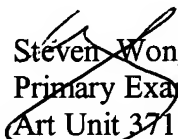
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however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Steven Wong whose telephone number is 571-272-4416. The examiner can normally be reached on Monday through Friday 7am-3:30pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Greg Vidovich can be reached on 571-272-4415. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


Steven Wong
Primary Examiner
Art Unit 3711

SBW
March 24, 2005